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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,301	04/13/2001	Patrick Fitzpatrick	50P3987.01	4748
26338	7590	03/01/2005	EXAMINER	
MERLE W. RICHMAN, III P.O. BOX 3333 LA JOLLA, CA 92038			KANG, INSUN	
			ART UNIT	PAPER NUMBER
			2124	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/835,301	Applicant(s) FITZPATRICK, PATRICK	
	Examiner Insun Kang	Art Unit 2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed 9/20/2004.
2. As per applicant's request, claims 1-4, 7-11, 15-18, 21-25, 29-32, and 35-39 have been amended. Claims 1-39 are pending in the application.

Claim Rejections - 35 USC § 112

3. The rejection to claims 2- 8, 10, 16-22, 24, 30-36, and 38 has been withdrawn due to the amendment to the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by MacInnis (US Patent 5,951,639).

Per claim1:

MacInnis discloses:

- downloading code to at least one remote unit on a network having a plurality of remote units wherein each remote unit has a plurality of data paths that can receive code (i.e. "selectively downloading software and data modules to terminals in a network... Each terminal receives the transmitted descriptors ... actual module may be downloaded in a "carousel" channel which continuously broadcasts all the various versions of modules in a loop," col 2 lines 17-42)

-selecting one of the plurality of data paths based on the code to be transmitted (i.e. "Each terminal extracts the descriptor table and , based on a match between an entry in the descriptor table and an internally stored table determines which version of a particular module should be downloaded," abstract)

-transmitting the code to the at least one remote unit on the selected data path (i.e. "The actual downloading procedure may be accomplished by selectively extracting the module from a separate channel on which transmitting source continuously broadcasts all versions of all the modules in a loop," col 4 lines 20-40)

as claimed.

Per claim 2:

The rejection of claim 1 is incorporated, and further, MacInnis discloses that the plurality of remote units are set top boxes (i.e. "home communication terminal," col 3 lines 10-27) as claimed.

Per claim 3:

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The rejection of claim 1 is incorporated, and further, MacInnis discloses that the code is software code used to update the software running on the at least one remote unit (i.e. "a updated software," col 1 lines 50-65; "automatically find the most recent version of the operating system to be downloaded for the terminal," col 2 lines 43-46) as claimed.

Per claim 4:

The rejection of claim 3 is incorporated, and further, MacInnis discloses that at least one data path of the plurality of data paths has a different data rate loss than the other data paths of the plurality of data paths (i.e. "transmitting soure... to a plurality of terminals... selects the "best" module version for that terminal," col 2 lines 30-42) as claimed.

Per claim 5:

The rejection of claim 4 is incorporated, and further, MacInnis discloses:
-selecting one of the plurality of data paths based on the code to be transmitted and the data rate loss of the path (i.e. "transmitting soure... to a plurality of terminals... selects the "best" module version for that terminal... in a "carousel" channel," col 2 lines 30-42) as claimed.

Per claim 6:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

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- selecting one of the plurality of data paths having the lowest data rate loss(i.e.

“transmitting source...to a plurality of terminals...selects the “best” module version for that terminal...in a “carousel” channel,” col 2 lines 30-42) as claimed.

Per claim 7:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

-selecting one of the plurality of data paths having the lowest data rate loss when the code represents critical software for the at least one remote unit (i.e. col 6 lines 13-25; col 2 lines 30-42) as claimed.

Per claim 8:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

- selecting one of the plurality of data paths having the lowest data rate loss where the code represents critical software stored in non-erasable memory of the at least one remote unit (i.e. “Instructions to execute...could be installed into ROM to prevent erasure or corruption,” col 7 lines 55-61) as claimed.

Per claim 9:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

- transmitting the code to the plurality of remote units in a descriptor file that indicates the at least one remote unit is a recipient of the code (i.e. “Each terminal extracts the descriptor table and, based on a match between an entry in the descriptor table and an internally stored table determines which of a particular module should be downloaded,” abstract) as claimed.

Per claim 10:

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The rejection of claim 8 is incorporated, and further, MacInnis discloses

- transmitting a descriptor file to the plurality of remote units that indicates at least one remote unit is to receive the code; and transmitting the code to the plurality of remote units (i.e. "downloading source transmits the descriptor table to each terminal and also continuously transmits the modules over the network," abstract) as claimed.

Per claim 11:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

- separating the code into a plurality of modules, transmitting a descriptor file to the plurality of remote units that indicates at least one remote unit is to receive the code and the code is separated into a plurality of modules; and transmitting the plurality of modules to the plurality of remote units. (i.e. "downloading source transmits the descriptor table to each terminal and also continuously transmits the modules over the network," abstract);

Per claim 12:

The rejection of claim 11 is incorporated, and further, MacInnis discloses

- each remote unit receiving the descriptor file (i.e. "Each terminal receives the transmitted descriptors," col 2 lines 30-42)

- each remote unit retrieving the modules identified by the descriptor file when the descriptor file indicates the remote unit is to receive the modules (i.e. "Each of the actual modules is preferably associated with a module identifier in table T, which is in turn associated with module descriptors," col 5 lines 1-7) as claimed.

Per claim 13:

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The rejection of claim 11 is incorporated, and further, MacInnis discloses

- each remote unit receiving the descriptor file(i.e. "Each terminal receives the transmitted descriptors," col 2 lines 30-42)
- each remote unit retrieving the modules identified by the descriptor file and assembling the modules into the code when the descriptor file indicates the remote unit is to receive the modules (i.e. "Each of the actual modules is preferably associated with a module identifier in table T, which is in turn associated with module descriptors," col 5 lines 1-7) as claimed.

Per claim 14:

The rejection of claim 11 is incorporated, and further, MacInnis discloses

- each remote unit receiving the descriptor file(i.e. "Each terminal receives the transmitted descriptors," col 2 lines 30-42)
- each remote unit retrieving the modules identified by the descriptor file(i.e. "Each of the actual modules is preferably associated with a module identifier in table T, which is in turn associated with module descriptors," col 5 lines 1-7)
- assembling the modules into the code, and installing the code when the descriptor file indicates the remote unit is to receive the modules(i.e. "Instructions to execute... could be installed into ROM to prevent erasure or corruption," col 7 lines 55-61) as claimed.

Per claims 15-28, they are the article of manufacture versions of claims 1-14, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1-14 above.

Per claims 29-39, they are the apparatus versions of claims 1-11, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1-11 above.

6. Claims 1, 15, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Gazda et al. (US Patent 6,453,470) hereinafter referred to as "Gazda."

Per claim 1:

Gazda discloses:

- downloading code to at least one remote unit on a network having a plurality of remote units wherein each remote unit has a plurality of data paths that can receive code to each remote unit comprising selecting one of the plurality of data paths based on the code to be transmitted and transmitting the code to the at least one remote unit on the selected data path (i.e. "An executable software path is selected from a plurality of available executable software paths according to the identifying information...the selected executable software path is executed at a processor of the terminal to initialize the hardware component," col 2lines 25-34) as claimed.

Per claim 15, it is the article of manufacture version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above.

Per claim 29, it is the apparatus version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above.

Response to Arguments

7. Applicant's arguments filed 9/20/2004 have been fully considered but they are not persuasive.

Per claim 1:

The Applicant states that MacInnis does not teach that a "particular channel is selected as a function of the module, code, or program to be transmitted (page 14)."

In response, the examiner points out that the claim is extremely broad reciting, "selecting one of the plurality of data paths based on the code to be transmitted and transmitting the code to the at least one remote unit on the selected data path" and the Applicant fails to discuss the references applied against the claim, specifically explaining how the claim avoids the references or distinguishes from them and to point out disagreements with the examiner's contentions. As has been addressed above, MacInnis discloses selecting the best module version for the matching (selected) terminal downloaded in a carousel channel (i.e. col. 2 lines 26-42; col. 4 lines 25-41; abstract).

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The applicant states that Gazda does not "mention the process of actually transmitting the software component to a set-top box and thus does not teach, suggest, or mutative one skilled in the art to practice the invention recited in claim 1 (page 14)."

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the feature upon which applicant relies, the set-top box, is not recited in the rejected claim 1. Although the claim is interpreted in light of the specification, limitations from the specification are not read into the claim. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As such, the claim is read with the broadest reasonable interpretation in mind (Note MPEP 2111).

Therefore, in view of the broadest reasonable interpretation, MacInnis and Gazda disclose the limitations in claim 1. Therefore, the rejection of claim 1 is considered proper and maintained.

Per claims 2-14:

The applicant fails to discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them and to point out disagreements with the examiner's contentions. As has been shown above, the rejection of independent claim 1 by MacInnis is proper, the argument that claims 2-14 are allowable as being dependent on an allowable base claim is considered moot. Accordingly, the rejections of claims 2-14 are proper and maintained.

Per claims 15 and 29:

The applicant states that the claims are allowable for the reasons set forth in connection with claim 1. As shown above, the rejections of claim 1 by MacInnis and Gazda were maintained, and accordingly, the rejections of claims 15 and 29 are also maintained.

Per claims 16-28 and 30-39:

The applicant fails to discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them and to point out disagreements with the examiner's contentions. As has been shown above, the rejections of independent claims 15, and 29 by MacInnis are proper, the argument that claims 16-28 and 30-39 are allowable as being dependent on the allowable base claims is considered moot. Accordingly, the rejections of claims 16-28 and 30-39 are proper and maintained.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724. The examiner can normally be reached on M-F 9:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 571-272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

I. Kang
Examiner
2/7/2005

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